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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/539,639

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EXAMINER

KOSACK, JOSEPH R

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

09/19/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/539,639	Applicant(s) ROQUES ET AL.	
	Examiner Joseph Kosack	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-52 is/are pending in the application.
- 4a) Of the above claim(s) 36-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-35 and 49-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/28/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 25-52 are pending in the instant application.

Amendments

The amendment filed on June 28, 2007 has been acknowledged and has been entered into the application file. Claims 49-52 are grouped with Applicant's election and are withdrawn in part under 37 CFR 1.142(b) as being drawn to a non-elected invention.

Information Disclosure Statement

The Information Disclosure Statement filed on June 28, 2007 has been considered fully by the Examiner.

Previous Claim Objections

Claims 25-35 were previously objected to for containing elected and non-elected subject matter. The non-elected subject matter has not been cancelled, and the objection stands.

Previous Claim Rejections - 35 USC § 112

Claims 25-26, 32, and 35 were previously rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has amended the claims to overcome the ambiguities with the Ψ -O-H limitation, and therefore the rejection is withdrawn for claims 26, 32, and 35. However, it cannot be seen from the examples that R_f can be attached to either carbon of the double bond as argued by the Applicant. Therefore, the rejection must stand for claim 25.

Previous Claim Rejections - 35 USC § 102

Claims 25-35 were previously rejected under 35 U.S.C. 102(b) as being anticipated by Lewis et al. (*Journal of the American Chemical Society*, 1968, 662-668).

Applicant has not traversed the rejection therefore the rejection is maintained.

Previous Claim Rejections - 35 USC § 103

Claims 25-35 were previously rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis et al. (*Journal of the American Chemical Society*, 1968, 662-668).

Applicant has traversed the rejection on the grounds that the prior art is very old, that the reference teaches away from acetate instead of trifluoroacetate, and that Lewis et al. does not have the same motivation as the Applicant.

The Examiner disagrees. First of all, the age of a reference has no bearing as to its applicability as art. Secondly, the reference does not teach away as it shows acetate compounds undergoing the rearrangement, yet having a lower susceptibility than the trifluoroacetate species. A proper defense of teaching away would show that either the combination does not work or that the combination is extremely unsuitable. This is not the case in that of trifluoroacetate is not even two-fold larger than that of acetate.

Additionally, it can be seen as a desirable result to have a compound that is less susceptible to rearrangement as stated by the Examiner in the previous action.

Therefore, Lewis et al. does not teach away from acetate. Finally, after the decision of KSR International Co. v. Teleflex Inc. (82 USPQ2d 1385), the court stated that, "The Circuit first erred in holding that courts and patent examiners should look only to the

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problem the patentee was trying to solve. Under the correct analysis, any need or problem known in the field and addressed by the patent can provide a reason for combining the elements in the manner claimed." Therefore, the motivation need not be the same as the Applicant's in their inventive process in order to render the invention obvious. The rejection is maintained.

Previous Double Patenting Rejections

Claims 25-35 were previously provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 4-6, 8-14, and 17 of copending Application No. 10/740,802. The copending application has been abandoned and is no longer copending. The provisional rejection is withdrawn.

Claim Objections

Claims 25-35 and 49-52 are objected to for containing elected and non-elected subject matter. The elected subject matter have been identified in the previous action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 25 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 25 recites Rf to be a radical carrying a perfluoromethylene group, which group provides the link with the remainder of the molecule. It is not known what the metes and bounds of Rf is as the definition of the "link with the remainder of the

molecule" cannot be found within the specification. Applicant may point out to the Examiner what is meant by the "link with the remainder of the molecule" from within the specification to assist in overcoming this rejection.

Claim Rejections - 35 USC § 102

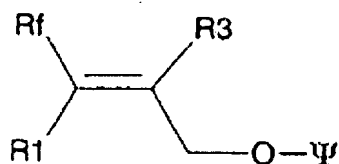
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 25-35 and 49-52 rejected under 35 U.S.C. 102(b) as being anticipated by Lewis et al. (*Journal of the American Chemical Society*, 1968, 662-668).

The instant application is drawn to compounds of the formula



where: Rf is trifluoromethyl; R1 and R3 are hydrogen; and Ψ

with the connecting oxygen is acetate or trifluoroacetate.

Lewis et al. teach a compound as described above where Rf is trifluoromethyl; R1 and R3 are hydrogen; and Ψ with the connecting oxygen is trifluoroacetate. See page 662, Table I, Compound V.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

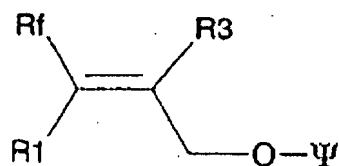
The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 25-35 and 49-52 rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis et al. (*Journal of the American Chemical Society*, 1968, 662-668).

The instant application is drawn to compounds of the formula



where: Rf is trifluoromethyl; R1 and R3 are hydrogen; and Ψ

with the connecting oxygen is acetate or trifluoroacetate.

Determination of the scope and content of the prior art (MPEP §2141.01)

Lewis et al. teach a compound as described above where Rf is trifluoromethyl; R1 and R3 are hydrogen; and Ψ with the connecting oxygen is trifluoroacetate. See page 662, Table I, Compound V.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

Lewis et al. do not teach the compound with Rf being trifluoromethyl and Ψ with the connecting oxygen is acetate.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

Lewis et al. teach various other compounds where Ψ with the connecting oxygen is acetate. See page 662, Table I, Compounds VII-XI, XVI, and XVII.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to take the compound of Lewis et al. with Ψ with the connecting oxygen is trifluoroacetate and replace the trifluoroacetate for acetate and make the claimed invention with a reasonable expectation of success. The motivation to do so is provided by Lewis et al. Lewis et al. teach that the acetate compounds are

more stable than the trifluoroacetate compounds and are less susceptible to rearrangement. See page 664.

Thus, the claimed invention as a whole was *prima facie* obviousness over the combined teachings of the prior art.

Conclusion

Claims 25-35 and 49-52 are rejected. Claims 25-35 and 49-52 are objected to.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Kosack whose telephone number is (571)-272-5575. The examiner can normally be reached on M-F 6:30 A.M. until 4:00 P.M. The examiner has every other Friday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph M^cKane can be reached on (571)-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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